

**AMENDMENTS TO THE DRAWINGS**

Please substitute the attached replacement sheets for currently pending Figs. 1-9.

Attachment:      Replacement sheets

### **REMARKS**

In response to the Office Action mailed October 17, 2006, Applicants respectfully request reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-51 were previously pending in this application. Claims 1, 7-13, 18, 24-30, 35, and 41-47 are amended herein. No claims have been cancelled. Claims 52-54 are added. As a result, claims 1-54 are pending for examination, with claims 1, 18, 35 and 52-54 being independent. No new matter has been added.

#### **Telephone Interview with Examiners**

Applicants' representatives thank Examiners Bibbee and Rimell for the courtesies extended in granting and conducting a telephone invention on January 16, 2007. The substance of the interview is summarized herein.

During the interview, Applicants' representatives provided an overview of one embodiment of the invention, which relates to a method of identifying a source location (e.g., a portion of a file, which may represent a securities filing) at which one or more data elements are stored, and recording an indication of the source location in electronic file storage (see, e.g., Applicants' specification at p. 2., lines 15-18). Using the indication of the source location stored in electronic file storage, a user or programmed procedure may, for example, access the data element(s) at the source location. For example, a user may wish to examine the data element(s) to verify the accuracy of certain information presented elsewhere, or may wish to review information relating to the data element(s) (p.2, lines 18-22). For example, a user reviewing a mutual funds sales commission structure on a web page might employ the indication of the source location to access a portion of a source securities filing containing detailed information on the sales commission structure for the security, so as to determine whether certain discounts apply to the user (p.2, lines 22-25).

The Examiners expressed an appreciation for the manner in which embodiments of the invention distinguish over the prior art of record. However, the Examiners also expressed an opinion that amendments to the independent claims might clarify that the “source location” is not a uniform resource locator (URL) at which a web page may be located, but rather a portion of a file in which one or more data elements is stored. Independent claims 1, 18 and 35 have been so amended.

#### Rejections Under 35 U.S.C. § 112

Claims 7, 24 and 41 are rejected under 35 U.S.C. § 112, ¶2, for purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. Specifically, the Office Action contends that the limitation “the characteristic” recited by each of claims 7, 24 and 41 lacks antecedent basis.

Each of claims 7, 24 and 41 are amended herein to replace the limitation “the characteristic” with the phrase “a characteristic of the data element.” Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, ¶2.

#### Rejections Under 35 U.S.C. § 101

Claims 1-51 are rejected under 35 U.S.C. § 101 as purportedly being directed to non-statutory subject matter. Specifically, the Office Action contends that claims 1, 18 and 35 are each directed to an abstract idea which fails to produce a useful, concrete and tangible result. Applicants respectfully traverse this rejection.

35 U.S.C. § 101 defines four categories of inventions which Congress has deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. Courts have interpreted § 101 to exclude abstract ideas, laws of nature and natural phenomena from these four statutory categories. However, practical applications of abstract ideas, natural phenomena and laws of nature which perform a real-world function may be patented. *See, e.g.,* Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p.17. To be considered a “practical application,” the claimed invention must

produce a “useful, concrete and tangible result.” State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

MPEP §2106(IV)(C)(2)(2) states that in determining whether a claimed invention is a practical application, the focus is not on whether steps taken to achieve the result are useful, tangible and concrete, but rather whether the result itself is useful, tangible and concrete. *See* MPEP §2106(IV)(C)(2)(2), page 2100-12 of Original Eighth Edition, Rev. 5, August, 2006. As explained below, the result achieved by each of independent claims 1, 18 and 35 (i.e., an identification of a source location, and the storage of an indication of the source location in electronic file storage) is useful, concrete and tangible.

A. The Identification Of A Source Location, And Indication Of Such An Electronic File Storage, Is A Useful Result

M.P.E.P. §2106(IV)(C)(2)(2)(a) states that, “for an invention to be “useful,” it must satisfy the utility requirement of §101.” *See* M.P.E.P. §2106(IV)(C)(2)(2)(a), pp. 2100-2112 of original 8<sup>th</sup> Ed., Rev. 5, August 2006. The M.P.E.P. general principles governing utility rejections instruct, “[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., that it has a “specific and substantial utility”) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.” *See* M.P.E.P. §2107(II)(B)(1), pp. 2100-2020 of original 8<sup>th</sup> Ed., Rev. 5, August 2006.

As explained below, the identification of a source location, and the storage of an indication of such in electronic file storage, has utility which is both specific and substantial.

I. The Identification Of A Source Location, And The Storage Of An Indication Of Such An Electronic File Storage, Has A Specific Utility

A specific utility is one that “is specific to the subject matter claimed and can “provide a well-defined and particular benefit to the public.” *See* M.P.E.P. §2107(.01)(I)(A), pp. 2100-2022 of original 8<sup>th</sup> Ed., Rev. 5, August 2006.

Each of claims 1, 18 and 35 explicitly recites identifying a source location and storing an indication of such an electronic file storage, such that the subject matter is specific to the claimed invention. The subject matter also provides a well-defined benefit to the public, as the identification of the source location, and the storage of an indication of such in electronic file storage, allows the public (e.g., a user or programmed procedure) to access one or more data elements at the source location. As a result, the subject matter claimed has specific utility.

II. *The Identification Of A Source Location, And The Storage Of An Indication Of Such An Electronic File Storage, Has A Substantial Utility*

“[T]o satisfy the ‘substantial’ utility requirement, an Applicant must show that the claimed invention has a significant and presently available benefit to the public.” *See* M.P.E.P. §2107(.01)(I)(B), pp. 2100-2023 of original 8<sup>th</sup> Ed., Rev. 5, August 2006. A reasonable use which the Applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining “substantial utility.” *See* M.P.E.P. §2107(.01)(I)(B), pp. 2100-2023-2100-2024 of original 8<sup>th</sup> Ed., Rev. 5, August 2006.

The identification of a source location, and the storage of an indication of such in electronic file storage, can allow a user or programmed procedure to access one or more data elements at the source location. This use is reasonable, and as discussed above, provides a benefit to the public. As a result, the claimed subject matter has a substantial utility.

In view of the foregoing, the identification of a source location, and the storage of an indication of such in electronic file storage, has a specific and substantial utility. Thus, the claimed subject matter satisfies the “useful” prong of the requirement of the claimed invention to yield a “useful, tangible and concrete” result.

B. *The Identification Of A Source Location, And The Storage Of An Indication Of Such An Electronic File Storage, Is A Tangible Result*

M.P.E.P. §2106(IV)(C)(2)(2)(b) states that the “tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. §101 judicial exception, and that the process claim must set forth a practical application of that judicial exception to produce a real-world result.” *See* M.P.E.P. §2106(IV)(C)(2)(2)(b), pp. 2100-2012 of original 8<sup>th</sup> Ed., Rev. 5, August 2006.

The identification of a source location, and the storage of an indication of such in electronic file storage, is a tangible result. It is not abstract, as it has a practical application and produces a real-world result. For example, it may allow one or more data elements stored at the source location to be accessed by a user or programmed procedure. Further, the storage of an indication of a source location in electronic file storage itself produces a tangible result, as it physically transforms the electronic file storage to a different state.

The Office Action contends, and the Examiners reiterated during the telephone interview, that in order to produce a tangible result, the claimed subject matter must include a presentation of the source location to a user. Applicants respectfully assert that this is incorrect, and that imposing such a requirement contravenes the explicit language of M.P.E.P. §2106(IV)(C)(2)(2)(b). As a result, Applicants respectfully request that if the rejection is to be maintained, the Examiners cite specific authority for the contention that information must be presented to a user for the result of a claimed process to be deemed tangible.

In view of the foregoing, Applicants respectfully assert that the identification of a source location, and the storage of an indication of such in electronic file storage, satisfies the “tangible” prong of the requirement that the claimed invention yield a “useful, tangible and concrete” result.

C. The Identification Of A Source Location, And The Storage Of An Indication Of Such An Electronic File Storage, Is A Concrete Result

M.P.E.P. §2106(IV)(C)(2)(2)(c) states that the question of whether an invention produces a concrete result “usually arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce

the same result again.” *See* M.P.E.P. §2106(IV)(C)(2)(2)(c), pp. 2100-2012 of original 8<sup>th</sup> Ed., Rev. 5, August 2006.

The identification of a source location, and the storage of an indication of such in electronic file storage, is a repeatable result. Applicants’ specification describes repeatable techniques for identifying a source location and storing an indication of such in electronic file storage. As a result, the claimed subject matter satisfies the “concrete” prong of the requirement that the claimed invention yield a “useful, tangible, and concrete” result.

D. Conclusion

In view of the foregoing, Applicants respectfully assert that the claimed subject matter produces a useful, concrete and tangible result. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-51 under 35 U.S.C. §101.

Rejections Under 35 U.S.C. §102(e)

Claims 1-51 are rejected under 35 U.S.C. §102(e) as purportedly being anticipated by U.S. Patent No. 7,020,667 to Guest et al. (“Guest”). As amended herein, claims 1-51 patentably distinguish over Guest.

A. Claims 1-17

Claim 1 recites a computer-implemented method of recording an indication or a source location at which a data element is stored. The method comprises acts of: (A) executing a set of programmed instructions to identify the source location, the source location comprising a portion of a file containing the data element; and (B) storing an indication of the source location in electronic file storage.

Guest fails to satisfy all of the limitations of amended claim 1. For example, Guest fails to disclose or suggest executing a set of programmed instructions to identify a source location comprising a portion of a file containing a data element.

Guest discloses a system which allows data presented on various web pages to be captured and loaded to a database, such that users may retrieve information from a variety of web pages and make the information available to other applications for further processing (Abstract; col. 2, lines 10-19). The system includes a graphical user interface (GUI) which allows the user to specify a uniform resource locator (URL) for a webpage (e.g., by copying and pasting the URL, or getting it from a “favorites” list) from which data is to be retrieved for loading to the database (col. 4, lines 47-49).

The system of Guest downloads the hypertext markup language (HTML) source constituting the webpage specified by the user, parses the HTML, and loads the parsed data into an array (col. 4, lines 57-59). Parsing the HTML source involves dividing the data into identifiable units of the webpage, replicating the webpage within the array, and displaying the data contained in the array to the user by via the GUI (col. 4, lines, 59-63). The user may choose data from the array to be retrieved on an ongoing basis from the webpage, and the system saves an indication of the data chosen by the user to an array locations file (col. 5, lines 12-14).

Guest does not disclose or suggest executing a set of programmed instructions to identify a source location comprising a portion of a file containing a data element. Rather, as described above, in the system of Guest the user identifies the source location (i.e., the placement in a particular portion of the array of particular data elements). An indication of the source location identified by the user is then saved to the array locations file.

As a result, Applicants respectfully assert that amended claim 1 patentably distinguishes over Guest, such that the rejection of claim 1 under 35 U.S.C. §102(e) as purportedly be anticipated by Guest should be withdrawn.

Claims 2-17 depend from claim 1 and are allowable for at least the same reasons.

B. Claims 18-34

Claim 18 recites a computer-readable medium having instructions encoded thereon which, when executed by a computer system, perform a method substantially similar to the method of claim 1. For the reasons discussed above in relation to claim 1, claim 18 patentably



distinguishes over Guest, such that the rejection of claim 18 under 35 U.S.C. §102(e) as purportedly being anticipated by Guest should be withdrawn.

Claims 19-34 depend from claim 18 and are allowable for at least the same reasons.

C. Claims 35-51

Claim 35 recites a system for recording an indication or source location at which a data element is stored. The system comprises processing means for executing a set of programmed instructions to identify the source location, the source location comprising a portion of a file containing the data element; and storage means for storing an indication of the source location in electronic file storage.

It should be appreciated from the discussion above relating to claim 1 that Guest fails to satisfy the limitations of claim 35, such that the rejection of claim 35 under 35 U.S.C. §102(e) as purportedly being anticipated by Guest should be withdrawn.

Claims 36-51 depend from claim 35 and allowable for at least the same reasons.

New Claims

New claims 52-54 have been added to further define Applicants' contribution to the art.

Claim 52 recites a method of accessing at least one data element stored at a source location. The method recites, inter alia, receiving a request from a user to access a source location, the source location comprising a portion of a file containing the at least one data element, the source location having been identified via an execution of a set of programmed instructions. As discussed above with reference to claim 1, the prior art of record neither discloses nor suggests executing a set of programmed instructions to identify a source location which comprises a portion of a file containing at least one data element. For at least this reason, claim 52 patentably distinguishes over the prior art of record.

Claim 53 recites at least one computer-readable medium having instructions encoded thereon which, when executed in a computer system, perform a method substantially similar to

the method of claim 52. For at least the reasons discussed above relating to claim 1, claim 53 patentably distinguishes over the prior art of record.

Claim 54 recites a system for accessing at least one data element stored at a source location. The system comprises, *inter alia*, request receipt means for receiving a request from a user to access the source location, the source location comprising a portion of a file containing the at least one data element, the source location having been identified via an execution of a set of programmed instructions. As discussed above with reference to claim 1, the prior art of record neither discloses nor suggests receipt means satisfying the limitations of claim 54. For at least this reason, claim 54 patentably distinguishes over the prior art of record.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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